REMARKS

Claims 1-27 are pending in the above-captioned patent application after this amendment. Claims 1-24 have been rejected. Claims 1, 23 and 24 have been amended to correct various informalities and/or to clarify what the applicant regards as the invention, and dependent claims 25-27 have been added, all for the purpose of expediting the patent application process in a manner consistent with the goals of the Patent Office pursuant to 65 Fed. Reg. 54603 (September 8, 2000), even though the Applicant believes that the previously pending claims were allowable.

Support for the amendments to the claims and for the new claims can be found throughout the originally filed application, including the originally filed claims, the drawings and the specification. More specifically, support for the amendments to claims 1, 12 and 23 and for new claims 25-27 can be found at least in Figures 1-4, in claims 1-22, and in the specification at page 3, line 17 through page 7, line 17.

No new matter is believed to have been added by this amendment. Consideration of the pending application is respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 12-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by Karasudani et al. (US 6,378,054). The Applicant respectfully traverses the rejection of claims 12-22 on the grounds that the cited reference does not teach or suggest the features of the rejected claims, and therefore does not support a rejection under 35 U.S.C. § 102(e), as set forth below. Additionally, as provided above, the Applicant has amended claims 23 and 24, which are believed to be allowable.

Karasudani et al. is directed toward a data backup device 40 that includes a first storage section 20 (memory A) and a second storage section 30 (memory B). Data files stored in the first storage section 20 are stored in the second storage section 30 in a duplicated manner. (Col. 8, lines 54-59; emphasis added). Memory A 20 and memory B 30 are each configured in the form of external storage devices such as hard disks. (Col. 8, lines 59-61). Thus, Karasudani et al. uses two separate storage devices 20, 30 to store the duplicative copies of the same data, some compressed and some uncompressed.

For example, Karasudani et al. teaches that the files in the first storage section 20 are analyzed by a selection section 101 of the CPU 10. The selection section 101 determines whether certain files in the first storage section 20 satisfy given conditions, such as having a particular maximum size. If the given conditions of certain data files are met, those certain files can be grouped together as an "archive file" from the first storage section 20, which is then copied in a duplicative manner to the second storage section 30 in compressed form. (Col. 14, lines 15-22; Figure 4). Files that do not satisfy the given conditions are simply copied without compression from the first storage section 20 to the second storage section 30, such as data files C and E. (Col. 14, lines 29-43; Figure 5). Karasudani et al. does not retrieve actual data files, compress these files and re-store them, but instead duplicates files that are then compressed and stored.

In another embodiment, certain data files from the first storage section 20 are first compressed, then are combined into an archive file that is stored in the second storage section 30. (Col. 14, lines 44-57; Figure 6). Thus, in each embodiment, Karasudani et al. teaches that data files from one storage section 20 are duplicated as data files and/or an archive file in compressed or uncompressed form, to the other storage section 30. Karasudani et al. does not teach or suggest that data files from the first storage section are retrieved, indiscriminately compressed without regard to size or other criteria, and re-stored in the backup storage device in a non-duplicative manner.

In contrast to Karasudani et al., claim 12 requires "a backup storage device; an input/output port; and a controller configured to transmit data received from the input/output port to the backup storage device during a backup period and then reclaim storage space on the backup storage device during an idle period following the backup period by retrieving the data stored on the backup storage device, compressing the retrieved data, and then re-storing the compressed data on the backup storage device." These features are not taught or suggested by Karasudani et al. Therefore, a rejection of amended claim 12 under 35 U.S.C. § 103(a) is unsupported. Because claims 13-22 depend directly or indirectly from claim 12, a rejection of these claims under 35 U.S.C. § 103(a) would also be unsupported by Karasudani et al.

Further, amended claim 23 requires the steps of "transmitting uncompressed

data from the primary storage device to the backup storage device during a backup window period; indiscriminately compressing the data during an idle period when uncompressed data is not being transmitted to the backup storage device; and re-storing the compressed data on the backup storage device so that the compressed data reclaims space on the backup device." These steps are not taught or suggested by Karasudani et al. Therefore, a rejection of amended claim 23 under 35 U.S.C. § 103(a) is unsupported. Because amended claim 24 depends from claim 23, a rejection of this claim under 35 U.S.C. § 103(a) would also be unsupported by Karasudani et al. As such, the rejection of claims 12-24 should be withdrawn, and these claims should be allowed.

Rejections Under 35 U.S.C. § 103

Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Karasudani et al. in view of Crighton (US 6,330,570). The Applicant has amended claim 1 to correct a clerical error as set forth above. The Applicant respectfully submits that the cited combination of references does not teach or suggest the features/steps of the rejected claims, and as such, the rejection should be withdrawn.

As set forth above, Karasudani et al. teaches that data files from one storage section 20 are duplicated, as data files and/or an archive file in compressed or uncompressed form, to the other storage section 30. Karasudani et al. does not teach or suggest that data files from the first storage section are compressed and re-stored in the backup storage device in a non-duplicative manner. In fact, Karasudani et al. teaches that the files are copied and stored, either in compressed or non-compressed form.

In contrast to the cited references, amended claim 1 is directed toward a method that includes the steps of "defining a duty cycle for the downloading of data to a backup storage device, the duty cycle having a backup window period and an idle period; receiving data during the backup window period; storing the data on the backup storage device during the backup window period; retrieving the data stored on the backup storage device during the idle period after the backup window period; compressing the data retrieved from the backup storage device during the idle period; and re-storing the data compressed during the idle period in compressed form on the backup storage

-9-

device." These steps are not taught or suggested by Karasudani et al. Therefore, a rejection of amended claim 1 is unsupported by the cited reference. Because claims 2-11 depend directly or indirectly from claim 1, a rejection of these claims under 35 U.S.C. § 103(a) would also be unsupported by the cited reference.

Additionally, the Patent Office states in its rejection that "it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify Karasudani by incorporating defining a duty cycle for the downloading of data to a backup storage device, the duty cycle having a backup window period and an idle period with the system of Crighton. Thus, one having ordinary skill in the art at the time the invention was made would have found it motivated to use such a modification because that would provide Crighton's system the enhanced and scheduled auto-data backup method in the data management system."

The Applicant respectfully disagrees with this rationale because the Applicant submits that there is no motivation to use the method taught by Crighton in Karasudani et al's device. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991; Emphasis added). In the present case, neither is found.

Even if the combination of references taught every element of the claimed invention (which it does not), without a motivation to combine, a rejection based on a prima facie case of obviousness has been held improper. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Further, the "mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990; emphasis original and added).

In the present case, the prior art does not clearly suggest the desirability of the resultant combination. Although Crighton suggests that an operator can select a backup period (and a pre-backup period), Crighton does not suggest that this backup time is selected so that any other processes can be performed during an idle period. In fact, Crighton teaches that the selection of the backup period to occur "later in the day"

-10-

is based on "lowering the risk that a new problem will be encountered." In other words, Crighton does not teach or suggest that the reason for the operator being able to select a backup period is to provide an idle period when other important processes (such as data compression, or any other process, for that matter) can occur.

Therefore, there is no suggestion or motivation provided in Crighton to combine the ability of an operator to select a backup period with the method of duplicating files onto two separate storage sections of a backup device taught by Karasudani. Thus, combination of these references is improper, and the rejection should be withdrawn.
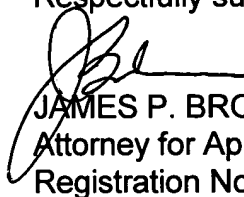
New Claims

Claims 25-27 have been added by this amendment. Claims 25-27 are of a slightly different scope than the previously pending claims. However, in view of the cited references, claims 25-27 are believed to be allowable. Further, as set forth above, claims 1, 12 and 23 are believed to be allowable. Because claims 25-27 depend from claims 1, 12 and 23, respectively, claims 25-27 are also believed to be allowable.

Conclusion

In conclusion, the Applicant respectfully asserts that claims 1-27 are allowable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 858-487-4077 for any reason that would advance the instant application to issue.

Dated this the 5th day of August, 2005.

Respectfully submitted,

JAMES P. BRODER
Attorney for Applicant
Registration No. 43,514

THE LAW OFFICE OF STEVEN G. ROEDER
5560 Chelsea Avenue
La Jolla, California 92037
Telephone: (858) 487-4077